

FUJIEDA et al., SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

Dkt. 503.39984X00/P5945/RH
Page 9

REMARKS

This Amendment is responsive to the Office Action Identified above, and is further responsive in any other manner indicated below.

PENDING CLAIMS

Claims 1-37 were pending in the application at the time of the Office Action. Appropriate claims have been amended, canceled and/or added (without prejudice or disclaimer) in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, such changes are unrelated to any prior art or scope adjustment and are simply refocused claims in which Applicant is presently interested. For example, Claims 5-7 and 14-18 have had the multiple-dependencies thereof amended to exclude multiple-dependent Claim 4. At entry of this paper, Claims 1-20 and 38-46 will be pending for further consideration and examination in the application.

REJECTION UNDER §112, 2ND PAR. OBIATED VIA CLAIM AMENDMENT

Claims 10, 12 and 19 have been rejected under 35 USC §112, second paragraph, as being indefinite for the concerns listed within the section numbered "1" on page 2 of the Office Action. Claims 10, 12 and 19 have been carefully reviewed and carefully amended where appropriate in order to address the Office Action listed concerns. Of particular interest, regarding Claim 10, the "balls" are the mechanical instruments used to effect the "mechanical alloying method," and are not the "composite powder." As the foregoing is believed to have addressed all §112 second

FUJIEDA *et al.*, SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

Dkt. 503.39984X00/P5945/RH
Page 10

paragraph concerns, reconsideration and withdrawal of the §112 second paragraph rejection are respectfully requested.

REWRITTEN ALLOWABLE CLAIMS

Claims 19/(1-4, 12) have been indicated as being allowable if rewritten, as indicated within the section number "10" on page 5 of the Office Action, and at least appropriate base ones of such claims have been so rewritten. That is, Claim 19 is prior Claim 19/1; Claim 38 is prior Claim 19/2; Claim 39 is prior Claim 19/3; and Claim 40 is prior Claim 19/12. Further, ones of such claims have been minorly amended (*e.g.*, to improve clarity, correct antecedents, remove extraneous portions) within this paper in a manner believed not to affect an allowability thereof. Accordingly, Claims 19, 38, 39 or 40 should now be allowable. Renewal of the allowance of such claims are respectfully requested. Applicant and the undersigned respectfully thank the Examiner for such indication of allowable subject matter.

ALLOWABLE CLAIMS DUE TO DEPENDENCY

Added Claim 41 is similar to Claim 4, but dependent from allowable Claims 19, 38, 39 or 40; and Claims 42-46 are similar to Claims 14-18, but dependent from allowable Claims 19, 38, 39 or 40. Accordingly, reconsideration and express written allowance of such Claims 41-46 are respectfully requested.

FUJIEDA *et al.*, SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

Dkt. 503.39984X00/P5945/RH
Page 11

REJECTIONS UNDER 35 USC §103 - TRAVERSED

All 35 USC §103 rejections are respectfully traversed. All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

In order to properly support a §103 obviousness-type rejection, the reference not only must suggest the claimed features, but also must contain the motivation for modifying the art to arrive at an approximation of the claimed features. However, the cited art does not adequately support a §103 obviousness-type rejection.

Applicant's disclosed and claimed invention is directed toward electromagnetic wave (EMW) absorber arrangements comprising composite magnetic particles in which a plurality of fine magnetic metal grains and ceramic are unified. Such unified magnetic-metal/ceramic composite EMW absorber may be used, for example, to encapsulate integrated circuits (see, *e.g.*, Applicant's FIG. 10), to prevent EMW from leaking to environments external to the IC package.

Rebutting the applied art, Takaragi *et al.* is not even directed to the EMW absorber art, and instead, is directed to magnetic particles used in the unrelated electrostatic latent image developer art. Even assuming *arguendo* that Takaragi *et al.*'s particles could be modifyingly used as EMW absorbers, courts have held that an Examiner cannot make substitutions at will to references in a hindsight attempt to arrive at Applicant's invention. The Federal Circuit has stated, "[t]he mere fact that

FUJIEDA *et al.*, SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

Dkt. 503.39984X00/P5945/RH
Page 12

the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14 (Fed. Clr. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Clr. 1984).

Turning next to Hakata *et al.*, the Col. 1, lines 51-61 teachings in Hakata *et al.* that are pointed to by the Office Action only relate to a background method of coating ultrafine particles by dispersing them into an inert gas stream and then coating them within the gas stream. Such does not result in Applicant's electromagnetic wave (EMW) absorber arrangements comprising composite magnetic particles in which a plurality of fine magnetic metal grains and ceramic are unified.

Next, Claussen *et al.* teaches a composite ceramic material having a matrix of AL₂O₃ to improve mechanical properties, e.g., fracture toughness. Rebuttal arguments concerning Claussen *et al.* are similar to those of Takaragi *et al.* That is, even assuming *arguendo* that Claussen *et al.*'s material could be modifyingly used as EMW absorbers, courts have held that an Examiner cannot make substitutions at will to references in a hindsight attempt to arrive at Applicant's invention. That is, the reference itself must provided the suggestion. Given that neither concerns EMW absorbers, a Claussen *et al.*/Takaragi *et al.* combination suffers the same fate as Claussen *et al.* or Takaragi *et al.* taken singly.

Other ones of the applied references appear also to have been cited in a hindsight manner to allege that other ones of Applicant's features/limitations were known in the art. For example, Mishihata appears to have been cited for teachings regarding polymers of high resistivity material; Darracq *et al.* appears to have been

FUJIEDA *et al.*, SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

Dkt. 503.39984X00/P5945/RH
Page 13

cited for teachings regarding cermet (*i.e.*, ceramic/metal) materials; and, Benjamin appears to have been cited for teachings regarding alloying using balls. However, none of the cited or applied references cure the deficiencies mentioned above with respect to the previously-discussed references.

In addition to the above, the following are comments from Applicant's foreign representative in support of the patentability of Applicant's invention.

With regard to the rejection of Claim 1, Applicant's present invention deals with an electromagnetic wave absorber. In contrast, Takaragi *et al.* deals with magnetic particles used for a "Electrostatic Latent Image Developer." Therefore, technical fields to which these inventions respectively belong are basically different from each other.

Further, the particle disclosed in Applicant's present invention is a composite magnetic particle into which magnetic metal grain and ceramic are unified. In contrast, Takaragai *et al.*'s particle is a combined fine particle of a simple two-layer structure comprised of ferrite particle having phenol resin coating thereon.

To summarize, what is offered by Applicant's present invention is an electromagnetic wave absorber having such a construction as is described in each claim, wherein the absorber provides excellent electromagnetic wave absorbing performance in high frequency region requiring reduced steps of manufacturing process therefor. However, the reference by Takaragi *et al.* basically gives no description of these advantages. Therefore, the present invention does not reside in the scope that is obvious to a person skilled in the art.

FUJIEDA *et al.*, SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

Dkt. 503.39984X00/P5945/RH
Page 14

Regarding the rejection of Claim 2, the description in Hakata's literature pointed out within the Office Action is a disclosure of merely "a method of forming a metallic coating on the surface of a line metal particle, ceramic particle, or plastic particle using sputtering or CVD method." This method, however, does not consider any construction such as Claim 2 defines, wherein "a plurality of fine magnetic metal grains and ceramic are unified by enclosing said plurality of fine magnetic metal grains with said ceramic." What is attained by Applicant's present invention is an electromagnetic wave absorber having such a construction as is described in each claim, wherein the absorber provides excellent electromagnetic wave absorbing performance in high frequency region requiring reduced steps of manufacturing process therefor.

Regarding the rejection of Claim 3, what the present invention claims is "an electromagnetic wave absorber." Claussen *et al.*, however, does not disclose any such feature. More particularly, in contrast, it is particularly pointed out that what Claussen *et al.* deals with is a fracture toughness property (Col. 11, lines 11-14), wherein a mechanical performance only is discussed.

Considering that the invention disclosed by Takaragi *et al.* is simply a magnetic particle used for "Electrostatic Latent Image Developer," an idea to combine this invention with the invention by Claussen *et al.* would not fall within the scope that is obvious to a person skilled in the art. Since neither reference provides teaching regarding use as an electromagnetic wave absorber, even if ideas by Claussen *et al.* and Takaragi *et al.* are combined, such combination would not have disclosed or suggested the electromagnetic wave absorber as defined in Claim 3.

FUJIEDA *et al.*, SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

Dkt. 503.39984X00/P5945/RH
Page 15

Regarding the rejection of Claims 4-8, 14-18, and 20, these claims are dependent, either directly or multiple-dependent, on Claims 1 -3. Applicant respectfully submits that the applied art would not have disclosed or suggested Applicant's claims for the same reasons as set forth above with respect to Applicant's Claims 1-3.

Regarding the rejection of Claim 9, Claim 9 defines a method of manufacturing an electromagnetic wave absorber. Darracq *et al.*, however, does not disclose any such feature. Further, what is mentioned therein is not a unified construction of magnetic grains and ceramic. That is, what is attained by Applicant's present invention is an electromagnetic wave absorber having such a construction as is described in each claim, wherein the absorber provides excellent electromagnetic wave absorbing performance in high frequency region requiring reduced steps of manufacturing process therefor.

As has been stated regarding Claim 2, the description in Hakata's literature pointed within the Office Action is a disclosure of "a method of forming a metallic coating on the surface of a fine metal particle, ceramic particle, or plastic particle using sputtering or CVD method." This method however does not consider any construction such that Claim 2 defines, wherein "a plurality of fine magnetic metal grains and ceramic are unified by enclosing said plurality of fine magnetic metal grains with said ceramic." This means that the composition discussed by Hakata is different from those construction dealt with in the present invention.

Regarding the rejection of Claims 10 and 12, their positions are the same as those of Claim 9; and accordingly, they are different from the cited references.

FUJIEDA *et al.*, SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

Dkt. 503.39984X00/P5945/RH
Page 16

As a result of all of the foregoing, it is respectfully submitted that the applied art (taken alone and in the Office Action combinations) would not support a §103 obviousness-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §103 rejection, and express written allowance of all of the §103 rejected claims, are respectfully requested. Further, at this point, it is respectfully submitted as a reminder that, if new art is now cited against any of Applicant's unamended claims, then it would not be proper to make a next action final.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

FUJIEDA *et al.*, SN 09/828,150
Amdt. dated 17 June 2004
Reply to OA mailed 17 February 2004

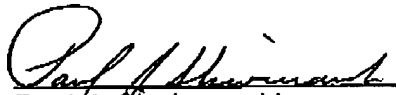
Dkt. 503.39984X00/P5945/RH
Page 17

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

A Petition for an extension of time is submitted concurrently herewith. To whatever other extent is actually appropriate and necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. Also submitted herewith is Form PTO-2038 authorizing payment of the requisite Petition fee. **No additional claim fees are required for entry of this Amendment.** Please charge any actual shortage in fees to ATS&K Deposit Account No. 01-2135 (referencing Case No. 503.39984X00).

Respectfully submitted,



Paul J. Skwierawski
Registration No. 32,173
ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209-3801, USA
Telephone 703-312-6600
Facsimile 703-312-6666

Concurrent Submissions:
Petition For Extension Of Time
Form PTO-2038 (Fee Code 1251)